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10/606,423	06/26/2003	Giovanni Seni	CML00362H	6310
7590	08/21/2006		EXAMINER	
Larson & Associates, P.C. 221 East Church Street Frederick, MD 21701-5405			BODDIE, WILLIAM	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/606,423	SENI, GIOVANNI	
	<b>Examiner</b>	<b>Art Unit</b>	
	William Boddie	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) 18,32 and 33 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Objections***

1. Claim 18 is objected to because of the following informalities: claim 18 states, “a local storage storing applications to be run on said PDA, said application data;”. This phrase is incorrect grammatically. Also it appears that the Applicant intended “said application data” to instead simply be “application data”, as there is no previous discussion of application data. Appropriate correction is required.
2. Claim 32 is objected to because of the following informalities: the phrase, “said conveyor area comprising one or more ink traces s;” appears to have an unintended “s.” Appropriate correction is required.
3. Claim 33 is objected to because of the following informalities: in the phrase “cancel and pending timeout events, and add an ink point to the conveyor area;” it appears the Applicant appears to have intended this phrase to read, “cancel any pending timeout events, and add an ink point to the conveyor area.” Note the period at the end of the phrase as well. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-9, 14-22 and 28-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,661,409. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims, as currently worded, are sufficiently anticipated by the published patent.

The following table is presented as an example as to how the similarities amongst the two sets of claims match up.

Current Application Claim 1	US Patent 6,661,409
An electronic device for written input and subsequent display of said written input, the electronic device comprising:	An electronic device for handwritten input and contemporaneous display of said handwritten input, the device comprising:
a touch input screen, said touch input screen operable to accept written input;	a housing having a touch input screen thereon for handwritten input by engagement therewith;
a display element, said display element operable to display one or more of recognized text and digital ink,	to text for display on the screen
wherein the recognized text is determined from the written input using a recognition feature coupled to the touch input screen and the digital ink, which may be edited by the user, corresponds to the written input; and	a recognition engine that recognizes the handwritten input and converts the recognized input
a scrolling mechanism coupled to the touch input screen that enables at least a	scrolling software that causes at least a portion of the screen to appear to

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portion of the touch input screen to appear to move as written entries are input thereon so as to continuously present screen space on the touch input screen to the user for written input.	continuously move as handwritten entries are input thereon so as to continuously present screen space on the screen to the user for input thereby maximizing character input rates.
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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11, 14-22 and 24-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Demartines et al. (US 6,661,409).

**With respect to claim 1,** Demartines discloses, an electronic device for written input and subsequent display of said written input, the electronic device (fig. 1) comprising:

a touch input screen (104-105 in fig. 1), said touch input screen operable to accept written input (col. 3, lines 43-47);

a display element (104, 105 in fig. 1), said display element operable to display one or more of recognized text and digital ink (col. 3, lines 53-56), wherein the recognized text is determined from the written input using a recognition feature coupled to the touch input screen and the digital ink (col. 3, lines 22-28), which may be edited by the user (col. 3, lines 29-39), corresponds to the written input; and

a scrolling mechanism coupled to the touch input screen that enables at least a portion of the touch input screen (104 in fig. 1) to appear to move as written entries are input thereon so as to continuously present screen space on the touch input screen to the user for written input (col. 4, lines 1-6).

**With respect to claim 2,** Demartines discloses, the electronic device of claim 1 (see above) wherein the screen is of a predetermined size (clear from fig. 1) and the screen portion (104) is smaller than the predetermined screen size (104 + 105) so that only the screen portion appears to move during written input (clear from figs. 1).

**With respect to claim 3,** Demartines discloses, the electronic device of claim 1 (see above) wherein the screen has an input area including the screen portion on which written input is entered and displayed (104 in fig. 1) and an output area separate from the input area on which one or more of corresponding digital ink and recognized text is displayed (105 in fig. 1).

**With respect to claim 4,** Demartines discloses, a handwritten input user interface (HIUI) (col. 2, line 50) for a portable device having a touch-enabled input screen with a predetermined area thereof (fig. 1), said HIUI comprising:

a handwriting input area (104 in fig. 1) residing in a predetermined portion of a touch-enabled input screen (104 + 105), handwritten text being entered using a stylus (col. 3, lines 20-21);

an input/display scrolling window in said handwriting input area, written entries being scrolled such that writing space is continuously available within said handwriting input area (col. 4, lines 1-6); and

a display area operable to display handwritten input as digital ink (col. 3, lines 53-56).

**With respect to claim 5,** Demartines discloses, a HIUI as in claim 4 (see above), wherein said handwritten input area includes a word separation line (120 in fig. 1) and spans said touch-enabled screen's width (claim 8).

**With respect to claim 6,** Demartines discloses, a HIUI as in claim 4 (see above), including a recognition engine (col. 3, lines 22-25) for recognizing individual words of the handwritten text, said recognized word operable to be displayed in the display area (col. 3, lines 25-29).

**With respect to claim 7,** Demartines discloses, a HIUI as in claim 4 (see above), wherein stylus entries made in said handwritten input are text entries (clear from 104 in fig. 1) and stylus entries made outside of said handwritten input area are pointer function entries (claim 13).

**With respect to claim 8,** Demartines discloses, a HIUI as in claim 4 (see above), further comprising one or more action icons (106-114 in fig. 1) on said touch-enabled screen displayed together on a side of said touch-enable screen.

**With respect to claim 9,** Demartines discloses, a HIUI as in claim 4 (see above) wherein a word separator is displayed in said handwritten input are to the right of words being entered (120 in fig. 1), entries to the right of said word separator indicating a start of a next word (col. 3, lines 57-67).

**With respect to claim 10,** Demartines discloses, a HIUI as in claim 4 (see above), wherein the handwritten input area is operable to display a menu of possible functions to the user (128 in fig. 2), said menu comprising one or more of:

- sending digital ink of the display area electronically to a remote destination;
- printing digital ink of the display area;
- erasing the digital ink from the display area;
- viewing the digital ink of the display area at a greater or lesser degree of resolution; and

applying a recognition engine to at least a portion of the digital ink of the display area (col. 4, line 64 – col. 5, line 26).

**With respect to claim 11,** Demartines discloses, a HIUI as in claim 10 (see above), further comprising one or more of:

- an undo button, said undo button operable to undo one or more actions performed within the display area;
- a menu button, wherein a display of the menu may be toggled using the menu button of the portable device;
- a keyboard button, said keyboard button operable to display a keyboard having alphanumeric or non-Western character data in the handwritten input area;
- a spacebar button, said spacebar button usable to insert a space in the display area;
- a backspace button (col. 5, lines 66-67), said backspace button usable to remove a portion of digital ink of the display area;

a new line button, said new line button usable to insert a new line at the user specified location of the display area.

**With respect to claim 14,** Demartines discloses, a HIUI as in claim 4 (see above), wherein the digital ink entered by the user is displayable using multiple ink line thicknesses (col. 5, lines 65-66).

**With respect to claim 15,** Demartines discloses, a HIUI as in claim 4 (see above), wherein the user can place a cursor for digital ink modification in the display area (col. 6, line 1).

**With respect to claim 16,** Demartines discloses, a HIUI as in claim 4 (see above), wherein the user can control the rate of scrolling (col. 5, lines 63-64).

**With respect to claim 16,** Demartines discloses, a HIUI as in claim 4 (see above), wherein the user can control a duration of a pen timeout (col. 5, lines 60-63).

**With respect to claim 18,** Demartines discloses, a personal digital assistant (PDA) (fig. 1) capable of displaying words in a continuous handwritten text stream, said PDA comprising:

a touch-enabled input screen (104, 105 in fig. 1);

a communications port for communicating with a remotely connected computer, data being transferred between said remotely connected computer and said PDA (col. 4, lines 20-22; also see claim 16);

a local storage storing applications to be run on said PDA, said application data (col. 3, lines 5-8);

a plurality of switches providing manual input to said PDA (col. 4, lines 22-24);

a handwritten input user interface (HIUI) comprising:

a designated handwriting input area residing in a lower portion of said touch-enable input screen (104 in fig. 1), handwritten words entered using a stylus or other functionally similar input device (col. 3, lines 19-22);

an automatically scrollable output area (104 in fig. 1), said handwriting input are being super-imposed on said scrollable output area (clear from fig. 1), said scrollable output area displaying digital ink strokes corresponding to stylus entries made in said designated handwriting input are, said scrollable output area scrolling continuously at a rate set by stroke rate (col. 2, lines 54-64);

a text output area (105 in fig. 1) operable to display the digital ink strokes corresponding to stylus entries made; and

one or more action icons displayed together on a side of said touch-enabled screen and providing access to editing functions for editing previously displayed words (106-114 in fig. 1).

**With respect to claim 19,** Demartines discloses, a method of providing written input to an electronic device (figs. 3-4), said method comprising:

receiving an entry from a written-entry screen area (152 in fig. 4);

displaying a corresponding digital ink stroke in said written-entry screen area (154 in fig. 4);

shifting each displayed digital ink stroke horizontally at a rate corresponding to an ink stroke rate of the digital ink, whereby written entries appears to be scrolling off one side of a display as on ticker tape (156-158 in fig. 4); and

displaying the written entries in a display area (164 in fig. 4).

**With respect to claim 20,** Demartines discloses, a method as in claim 19 (see above), wherein displaying the written entries in the display are further comprises:

performing one or more of:

passing said received entry to a handwriting recognition engine, said handwriting recognition engine converting said received entry to text (160-162 in fig. 4);

converting the written entries to digital ink; and

displaying one or more of text and digital ink in a textual display area.

**With respect to claim 21,** Demartines discloses, a method as in claim 20 (see above), wherein the shifting displayed digital ink strokes includes displaying a word separator indicating a point on the written entry screen area designating demarcation between continuation of a current word and initiation of a next word (col. 3, lines 57-67).

**With respect to claim 22,** Demartines discloses, a method as in claim 21 (see above), wherein said word separator scrolls with a written entry when written input is determined to have paused (col. 4, lines 7-9).

**With respect to claim 24,** Demartines discloses, a HIUI as in claim 19 (see above), wherein the user can edit handwriting in the display area, further comprising one or more of:

deleting one or more portions of ink traces of the digital ink;

inserting one or more spaces between ink traces of the digital ink;

removing one or more spaces between ink traces of the digital ink; and

inserting one or more new lines within ink traces of the digital ink (note the new line tool, 108 in fig. 1).

**With respect to claims 25-27**, as these claims further limit events that were not explicitly required by the parent claim they are rejected here on the same merits as the parent claim 24.

**With respect to claim 28**, Demartines discloses, a HIUI as in claim 19 (see above), wherein the user can draw without having the input area scroll, comprising:

user entering a pause mode by pressing a user interface button (scrolling animation object), said pause mode is operable to prevent input screen from scrolling;  
user drawing within input screen; and  
user exiting pause mode whereby what was drawn is placed in the display area (col. 6, lines 14-16).

**With respect to claim 29**, Demartines discloses, a computer program product for inputting written entries into a computer (col. 5, lines 27-31), said computer program product comprising a computer usable medium having computer readable program code thereon, said computer readable program code comprising:

computer readable program code means for continuously receiving written entries (col. 3, lines 29-32);  
computer readable program code means for converting said written entry into digital ink (col. 3, lines 53-56);  
computer readable program code means for setting a scrolling speed responsive to an entry input rate (col. 3, lines 25-29);

computer readable program code means for displaying newly entered said digital ink and removing previously displayed written input from an input display at a rate set by said controlling speed, displayed said written input appearing as if on a ticker tape (col. 3, lines 15-39); and

computer readable program code means for displaying current and previous written input in an output display element (col. 3, lines 25-27).

**With respect to claim 30,** Demartines discloses, a computer program product for inputting written entries into a computer as in claim 29 (see above), further comprising:

computer readable program code means for identifying individual words and calling handwriting recognition (col. 4, lines 31-45); and

computer readable program code means for recognizing written words and providing recognized said words to the output display element (col. 3, lines 42-47).

**With respect to claim 31,** Demartines discloses, a computer program product for inputting written entries into a computer as in claim 29 (see above) wherein the computer readable program code means for receiving written entries further comprises:

computer readable program code means for determining whether said written entries are being made in an input area of a touch sensitive screen or in an other area of said touch sensitive screen than said input area (col. 5, lines 43-46); and ..

computer readable program code means for providing commands responsive to entries in said other area, entries in said input area being received as written entries (note the file menu in fig. 1).

**With respect to claim 32,** Demartines discloses, an electronic device for handwritten input and subsequent display of said handwritten input (fig. 1), the electronic device functionally comprising:

a user interface having an ink text canvas (105 in fig. 1) and a conveyor canvas (104 in fig. 1);

one or more ink text areas coupled to the ink text canvas (note the words displayed in 105 in fig. 1);

a conveyor area, coupled to the one or more ink text areas and coupled to the user interface (col. 3, lines 15-39; discloses the connection amongst the input text and the displayed text), said conveyor area comprising one or more ink traces (note the written words in 104 in fig. 1);

an event loop of the user interface (fig. 3), said event loop operable to respond to one or more of:

pen down events;

pen up events;

pen move events (col. 5, lines 35-37); and

pen timeout events.

**With respect to claims 33, 35-38,** as these claims further limit events that were not explicitly required by the parent claim they are rejected here on the same merits as the parent claim 32.

**With respect to claim 34,** Demartines discloses, the electronic device of claim 32 (see above), wherein upon an occurrence of a pen move event, an ink point is added to a current ink trace of one or more ink traces (col. 5, lines 35-37).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demartines et al. (US 6,661,409).

**With respect to claims 12 and 13,** Demartines discloses, a HIUI as in claim 4 (see above).

While Demartines does not expressly disclose offering display of digital ink in a variety of colors and sizes these limitations are seen as simple design choices that are quite obvious in the art. As such they are not seen as patentably distinguishing over the state of the art at the time of the invention.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Demartines et al. (US 6,661,409) in view of Lui et al. (US 6,256,009).

**With respect to claim 23,** Demartines discloses, a HIUI as in claim 19 (see above).

Demartines does not expressly disclose, wherein the user can insert print characters within the digital ink of the display are further comprising activating a

keyboard from a menu, said keyboard operable to be used to enter alpha-numeric characters intermingled with the digital ink.

Lui discloses, the activating of a keyboard in a touch screen device to insert alpha-numeric characters (note the keyboard icon in fig. 5; col. 1, lines 18-27).

Lui and Demartines are analogous art because they are both from the same field of endeavor namely, scrolling user interfaces for use in PDAs.

At the time of the invention it would have been obvious to one of ordinary skill in the art to allow the user to activate a keyboard to input alpha-numeric characters, taught by Lui, into the device of Demartines.

The motivation for doing so would have been to allow word input without being concerned with handwriting legibility.

Therefore it would have been obvious to combine Demartines with Lui for the benefit of ease of use when handwriting could be illegible to obtain the invention as specified in claim 23.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Will Boddie whose telephone number is (571) 272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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